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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,428	11/17/2003	Charles J. Rizzo	Magna-001001	2745

7590 06/14/2005  
 Law Office of Andrew Bodendorf  
 1727 King Street  
 Suite 105  
 Alexandria, VA 22314-2700

EXAMINER

SILBERMANN, JOANNE

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,428

Applicant(s)

RIZZO ET AL.

Examiner

Joanne Silbermann

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30, 32, 33 and 36-49 is/are pending in the application.
- 4a) Of the above claim(s) 33 and 36-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30, 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12-9-04</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly amended claims 33, 36-49 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are now directed toward a business method, specifically the distribution and redemption of a coupon or incentive or promotion program.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 33, 36-49 stand withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huellinghoff et al. US #6,347,469 in view of Stone US #5,680,709.

4. Huellinghoff et al. teach a user-customizable magnetic display including first portion 30 and second portion 32 (Figure 1). Boundary 50 therebetween may be perforated (column 3 lines 1-2). Second portion 32 includes information 62 and 72 and

may receive written indications in designated areas. First portion 30 includes message portions 48. The shape is considered to be identified with a business.

5. Huellinghoff et al. do not teach applying a medium to the first portion by means of adhesive, however this is well known in the art, as shown by Stone. Stone teaches that it is old and well known to apply a display such as a business card to a magnetic backing by using adhesive (column 4 lines 35-44 and column 4 line 66 through column 5 line 1) and a protective sheet over the adhesive (column 3 lines 53-55). It would have been obvious to a person having ordinary skill in the art to utilize the personalized message of Stone on the display of Huellinghoff et al. so that the message portion of the display may be personalized.

6. Huellinghoff et al. and Stone do not teach the display as being a coupon, or having a date and time etc. However, the particular type of indicia on the display appears to be entirely a matter of design choice. Applicant's claims have been carefully considered and there does not appear to be any new and unobvious functional relationship between the printed matter and the substrate. It would have been obvious to one of ordinary skill in the art to utilize any indicia needed to convey the desired message. Additionally, patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure.

7. Huellinghoff et al. and Stone do not specify the particular shape or dimensions of the display, however it would have been obvious to one of ordinary skill in the art to utilize a first surface large (or small) enough to accommodate a desired display. Also, matters relating to ornamentation only, and having no mechanical function, cannot be

relied on where claims are not directed to design but are structural claims. In re SEID, 73 USPQ 431 (CCPA 1947).

### ***Response to Arguments***

8. Applicant's arguments filed March 31, 2005 have been fully considered but they are not persuasive.

9. Applicant argues that the combination taught by the references would not result in Applicant's invention because the dimensions of the device would be different and because the display panel and the message section would be the same size. As discussed in the above rejection, the size of the display device would have been obvious to one of ordinary skill. Also, a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Regarding the components being the same size, this is not taught by Huellinghoff et al. As discussed above, it would have been obvious to modify Huellinghoff to include adhesive to hold the display to the magnetic backing. This does not necessarily mean that the two must be the same dimensions.

10. Regarding the method claims, Applicant's amendments regarding customers and receiving products or services in exchange for coupons is considered to be a method of doing business. These claims stand withdrawn, since an action has previously been given on article claims.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joanne Silbermann

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Primary Examiner  
Art Unit 3611

JS